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U.S. Application No. 10/733,192 Art Unit 2681  
Response to June 9, 2006 Office Action

### **REMARKS**

In response to the Office Action dated June 9, 2006, the Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents.

Claims 1-3 and 5-15 are now pending in this application. Claims 4 and 16-18 have been canceled.

The United States Patent and Trademark Office (the "Office") rejected claims 13-16 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,675,008 to Paik *et al.* Claims 1-4, 6, 8-12, and 17-18 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Paik in view of U.S. Patent 6,061,560 to Saboorain *et al.* Claim 5 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Paik in view of Saboorain and further in view of Published U.S. Application 2004/0209604 to Urban *et al.* Claim 7 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Paik in view of Saboorain and further in view of U.S. Patent 5,553,125 to Martensson.

The Assignee shows, however, that the pending claims recite features not taught or suggested by Paik, Saboorain, Urban, and Matensson. The pending claims, therefore, cannot be anticipated or obviated by Paik, Saboorain, Urban, and Matensson, whether considered alone or in any combination.

### **Rejection of Claims Under 35 U.S.C. § 102**

The Office rejected claims 13-16 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,675,008 to Paik *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P.").

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Claims 13-16, however, are not anticipated. Independent claim 13 recites features that are not disclosed by *Paik*. Independent claim 13, for example, recites “a receiver wirelessly receiving only the called line identification information from a base station.” A display “continuously presenting the called line identification information for a duration of the outgoing call.” Independent claim 13 also recites “wherein when the calling line identification information is received, the device presents the calling line identification information to the subscriber, thus informing the subscriber of a called number associated with the outgoing call.” Support for such features may be found at least at paragraphs [0007] and [0028] of the as-field application. A “clean” version of independent claim 8 is reproduced below.

[c13] (Currently Amended) A device for alerting a subscriber of called line identification information associated with an outgoing call, the device comprising:

a receiver wirelessly receiving only the called line identification information from a base station; and

a display continuously presenting the called line identification information for a duration of the outgoing call,

wherein when the called line identification information is received, the device presents the called line identification information to the subscriber, thus informing the subscriber of a called number associated with the outgoing call.

*Paik* fails to disclose such features. No where does *Paik* disclose “a receiver wirelessly receiving only the called line identification information from a base station.” Moreover, *Paik* does not “continuously present” called line identification information “for a duration of the outgoing call,” as independent claim 13 recites. *Paik*, in contradistinction, uses “caller information” to select picture, audio, or character information for incoming calls. See, e.g., U.S. Patent 6,675,008 to *Paik et al.* (Jan. 6, 2004) at column 1, lines 40-45 and lines 53-65 (emphasis added). See also *id.* at column 5, lines 40-45; at column 8, lines 37-55; at column 9, lines 30-35 and 52-67. No where does *Paik* disclose “a receiver wirelessly receiving only the called line identification information from a base station” and “a display “continuously presenting the

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called line identification information for a duration of the outgoing call.” Because *Paik* is entirely silent to these features, the patent to *Paik et al.* cannot anticipate independent claim 13. The Assignee thus respectfully requests removal of the § 102 (e) rejection of claims 13-16.

### **Rejection of Claims Under 35 U.S.C. § 103**

Claims 1-4, 6, 8-12, and 17-18 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Paik* in view of U.S. Patent 6,061,560 to *Saboorain et al.* Claim 5 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Paik* in view of *Saboorain* and further in view of Published U.S. Application 2004/0209604 to *Urban et al.* Claim 7 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Paik* in view of *Saboorain* and further in view of U.S. Patent 5,553,125 to *Martensson*.

If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter “M.P.E.P.”).

For the following reasons, however, the *prima facie* cases for obviousness must fail.

1. **All the Proposed Combinations of *Paik*, *Saboorain*, *Urban*, and *Matensson* Fail to Teach or Suggest All the Features of the Claims, so the § 103 (a) Rejections are Improper**

The pending claims cannot be obvious. All the pending claims recite, or incorporate, features that are not taught or suggested by *Paik*, *Saboorain*, *Urban*, and *Matensson*, whether alone or in any combination. All the cited documents, for example, fail to teach or suggest “a receiver wirelessly receiving only the called line identification information from a base station”

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and “a display “continuously presenting the called line identification information for a duration of the outgoing call.” The cited documents also fail to teach or suggest “wherein when the calling line identification information is received, the device presents the calling line identification information to the subscriber, thus informing the subscriber of a called number associated with the outgoing call.” All the proposed combinations utilize Paik’s “caller information” to select picture, audio, or character information for incoming calls. Because Paik, Saboorain, Urban, and Matensson are all silent to many features of the pending claims, the *prima facie* cases for obviousness must fail. The Assignee respectfully requests removal of the § 103 (a) rejections.

**2. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Cases for Obviousness Are Improper**

The Examiner’s *prima facie* cases for obviousness are defective. The Examiner’s *prima facie* case for obviousness must include “a reasonable expectation of success.” DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition). Here, however, the Examiner’s *prima facie* cases wholly fail to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* cases for obviousness must fail. The Assignee thus respectfully asserts that the § 103 (a) rejections of the pending claims should be removed.

**3. Because No “Teaching, Suggestion, or Motivation” was Cited, the § 103 (a) *Prima Facie* Cases for Obviousness Are Improper**

The Examiner’s *prima facie* cases for obviousness are defective for another reason. The Examiner’s *prima facie* cases for obviousness must include “some teaching, suggestion, or motivation” to combine documents. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition). Here, however, the Examiner’s *prima facie* cases wholly fail to include any “teaching, suggestion, or motivation” to combine documents. The Examiner, then, has failed to carry the burden, so the *prima facie* cases for obviousness must

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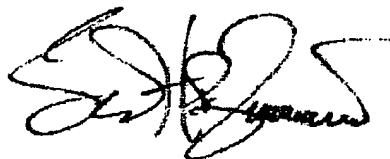
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fail. The Assignee thus respectfully asserts that the § 103 (a) rejections of the pending claims should be removed.

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If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@wzpatents.com](mailto:scott@wzpatents.com).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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